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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,170	09/07/2004	Yasuo Ohdaira	522.1025	4081

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EXAMINER	
SAYALA, CHHAYA D	

ART UNIT	PAPER NUMBER
1794	

MAIL DATE	DELIVERY MODE
10/29/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/507,170	OHDAIRA ET AL.	
	Examiner	Art Unit	
	C. SAYALA	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *7/15/2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *4-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *4-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. Claims 4-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1155623 and JP 2000032924 in view of in view of Song et al. (US Patent 6737065) and Suzuki et al. (see IDS filed 11/3/04, Reference A6) and further in view of JP 03-076539 and Protti (5536509)

.

The EP patent teaches Grifola in the form of an extract, in the dried form (paragraph [0010], claim 1) for feeding animals in an amount 0.01 – 20 wt % (claim 4); wherein the animal is a mammal, chicken or pig (paragraph [0013]). The fungi is said to be an antimicrobial (paragraph [0016]) and as a growth promoter (paragraphs [0011] and [0014]).

The JP '924 patent shows feeding horses the extract or powder of maitake mushroom, which gives improvement in health condition, as well as acts as an immunostimulant. The amount is given as 60-525 mg/kg/day. A horse is a domestic animal bred for its meat too.

Though both the primary patents teach the benefits of feeding Grifola to domestic animals in the amounts claimed, they do not teach the yeast-derived ingredient. They do not expressly state that the meat is of good flavor, as per instant claims 12-13. Song et al, and Suzuki et al., both teach

that the quality of the meat is improved by feeding such mushrooms, see '065 abstract and claims, which disclose that Grifola, one of the mushrooms fed to ducks gave meats with excellent taste and quality, while Suzuki et al teach maitake mushroom improved the quality of cattle overall, which renders obvious that the meat had good flavor, since good quality meat results in having good flavor.

JP '539 teaches adding yeast in dairy feed to increase animal weight. Note the amounts. Protti teaches yeast as improving health and growth of cattle, horses and chicken, and note the amounts shown. See abstract and claims 7, 9 and 10 etc. To combine the composition containing Grifola with that of yeast, each shown useful for its own purpose, and to optimize amounts within those shown so as to produce optimum beneficial results would have been obvious and within the ambit of ordinary skill. Note that Grifola has been shown to be a growth promoter by the EP patent and Priotti teaches the yeast also as improving growth.

Response to Arguments

Applicant's arguments filed 7/15/2008 have been fully considered but they are not persuasive.

Applicant has relied on unexpected results obtained by practicing the invention described at page 11 wherein Grifola-derived substance is combined with yeast-derived substance. The results applicant relies on have been carefully reviewed. When 0.2% of the feed additive containing Grifola or Grifola combined with yeast was used for animals, the last paragraph of page 11 observes "excellent results" were obtained. Average body weights of animals were 2.919, 2.934 and 2.911 kg for Grifola, Grifola and yeast, and control, respectively.

It is well established that the advantage relied upon must be a significant advantage. In re Nolan, 193 USPQ 641. It is also well established that the objective evidence of nonobviousness must be commensurate in scope with the claims. See In re Hyson, 172 USPQ 399, In re Tiffin, 171 USPQ 294, In re Lindner, 173 USPQ 356.

Claim 1 recites no amounts. Claim 10 recites only amounts 5-600 mg/day/kg (i.e. the same amount shown for Grifola by JP '924), which amounts do not appear to have antecedent basis in the specification and inarguably are not commensurate in scope with the amounts used to show unobvious results. The correspondence therefore, of the amounts in the claims and those pointed out at page 11, showing unexpected results, is unclear.

While applicant states (at page 7) that neither JP '539 nor Protti teaches a Grifola derived substance, and while this is true, as noted in the rejection (emphasis added):

JP '539 teaches adding yeast in dairy feed to increase animal weight. Note the amounts. **Protti teaches yeast as improving health and growth of cattle, horses and chicken,** and note the amounts shown. See abstract and claims 7, 9 and 10 etc. To combine the composition containing Grifola with that of yeast, each shown useful for its own purpose, and to optimize amounts within those shown so as to produce optimum beneficial results would have been obvious and within the ambit of ordinary skill. **Note that Grifola has been shown to be a growth promoter by the EP patent and Priotti teaches the yeast also as improving growth.**

Thus, these patents disclose yeast-derived substances, used in the same amounts as claimed, as being useful for increasing the growth of animals. Therefore, if Grifola-derived substances also, showed an increase in growth of animals, then to combine such substances would have been prima facie obvious. It is prima facie obvious to combine two compositions, each of which is taught by the prior art to be useful for the same purpose, in order to form a third

composition to be used for the very same purpose. In re Kerkhoven 205 USPQ 1069. The idea of combining these compositions flows logically from their having been individually taught in the prior art as being useful. In re Crockett 126 USPQ 186, 188.

Whereas the references show both Grifola-derived substance and yeast-derived substance useful in the amounts disclosed by these references for improving the health and growth of domestic animals, and whereas applicant has pointed to unobvious results by combining these substances in a particular manner and feeding the same animals as disclosed by the references, the claims however, are not confined to the same manner of feeding the combination of substances as far as amounts are concerned.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Sayala whose telephone number is (571) 272-1405. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. SAYALA/
Primary Examiner, Art Unit 1794